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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,939	05/30/2006	Robin Miheckun Miller	60469-094PUS1; OT-5208LAB	8921
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CARLSON GASKEY & OLDS 400 W MAPLE STE 350 BIRMINGHAM, MI 48009				
EXAMINER				
KRUER, STEFAN				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,939

Applicant(s)

MILLER ET AL.

Examiner

Stefan Krueer

Art Unit

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 21 is/are pending in the application.
- 4a) Of the above claim(s) 14 - 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 13 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 30 May 2006

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Claims 1 – 13 and 21 in the reply filed on 19 June 2008 is acknowledged. The traversal is on the ground(s) that the examiner has improperly cited MPEP § 809.02(a) and 37 CFR § 1.414 in referencing protocol to establish a requirement for restriction, as well as the supposition that the claims specific to all species of the first invention (Group I) were not found to be unpatentable over prior art, thereby not fulfilling the requirements of restriction pursuant to the applicant's application filed under 35 U.S.C. 371 for National Stage Applications. Furthermore, applicant noted that no lack of unity for the PCT-application was determined during its prosecution.

This argument is not found to be persuasive because the generic claim(s) is not allowable over prior art of record as follows.

Furthermore, in that the independent claims with respect to an apparatus commonly recite a guide rail comprising a first material, a second material and a nose portion whereas the independent claims with respect to a method of making said apparatus commonly recite forming a rail body using a first material (therein neither limiting said apparatus as formed from only a first material nor definitively excluding the "use" of a first material in making the apparatus, wherein said apparatus can be of another, or additional, indeterminate material) and covering said rail body with a second material, said method(s) are applicable to making products other than guide rails, e.g. monorails and tracks, Class 238, subclass 130, as well as method of making a rail, Class 29, Subclass 897.35 or 525.13.

Consequently, the requirement is still deemed proper and is therefore made FINAL.

In that the elected claims are directed to a product and the non-elected claims are directed to a process of making the product, should the elected claims be deemed allowable, the claims previously withdrawn from consideration as a result of a restriction

requirement will be rejoined and fully examined for patentability under 37 CFR 1.104, pursuant to the procedures set forth in MPEP § 821.04(B)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 5, 8 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivera (5,673,771).

Re: Claims 1 – 5, 8 and 21, Rivera discloses a guide rail (106) for use in an elevator system (102, 104), comprising:

- a first material body (118, Col. 3, L. 31) having a nose portion (142); and
- a second material (116) secured to at least some of the nose portion, wherein the second material comprises steel (Col. 3, L. 48)
- wherein the second material establishes a covering that extends along an entire longitudinal length of the guide rail covering at least some of the nose portion;
- wherein the second material comprises a steel sheet that is shaped to conform to the nose portion and including a bonding agent (132, 134, 136) between the steel sheet and the nose portion;
- wherein the nose portion includes at least one recess (128) and the second material has a portion (136) extending at least partially into the recess;
- an insulating layer (Col. 3, L. 65 - Col. 4, L. 14) between the nose portion and the second material; and
- wherein the first material comprises aluminum (Col. 3, L. 31).

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Richter et al (6,006,867).

Richter et al disclose a guide rail (2, Fig. 1)) for use in an elevator system (Abstract), comprising:

- a first material body (2) having a nose portion (portion opposite 11, Fig. 2); and
- a second material (comprising 20) secured to at least some of the nose portion, wherein the body comprises a base portion (B, Fig. 1) that is adapted to be secured to a stationary structure (S) and the nose portion extends away from the base portion at an oblique angle.

In **Claim 13**, an element that is "adapted to" perform a function is not a positive limitation and only requires the ability to so perform, in re Hutchinson 69 USPQ 138.

Claims 1 – 5, 8 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mier (5,061,829).

Re: Claims 1 – 5, 8 and 21, Mier discloses a guide rail (106) *for use in an elevator system*, comprising:

- a first material body (10, Fig. 2, Col. 2, L. 9) having a nose portion (28); and
- a second material (12, Col. 2, L. 9 and Col. 5, L. 14) secured to at least some of the nose portion, wherein the second material comprises steel;
- wherein the second material establishes a covering that extends along an entire longitudinal length of the guide rail covering at least some of the nose portion (Fig.'s 8 and 9);
- wherein the second material comprises a steel sheet that is shaped to conform to the nose portion and including a bonding agent (26, 34, Fig. 3 and 20, 16, Fig. 9) between the steel sheet and the nose portion;
- wherein the nose portion includes at least one recess (26) and the second material has a portion (24) extending at least partially into the recess;
- an insulating layer (32) between the nose portion and the second material; and
- wherein the first material comprises aluminum (Col. 2, L. 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 - 7 and 9 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera in view of Matsui et al (5,244,746).

Re: Claims 6 – 7, Rivera discloses an insulating layer(s); however, Rivera is silent with respect to its material of construction, other than that the insulating layer(s) may be "... optimized to provide other benefits...".

Attention is directed to Matsui et al who reviews the necessary structural integrity of his composite guide rail to address the "... strong shearing stresses and violent thermal behavior... imparted to the composite structure" (Col. 2, L. 34).

In that Rivera reviews the applicability of insulation optimized to provide unrestricted benefits and Matsui et al teach the relevance of his invention in addressing shear stresses and violent thermal behavior, the use of an insulating material such as glass fiber to accommodate the generation of heat attributable to braking would have been obvious to one having ordinary skill in the art.

Re: Claim 9, Rivera is silent with respect to his bonding agent comprises at least one of an adhesive or concrete.

Attention is directed to Matsui et al who teach their bonding agent (12, Col. 7, L. 68 – Col. 8, L. 2) is an adhesive to join their first (3) and second (2) materials to provide a composite structure of dissimilar metals for resistance to shear and avoidance of galvanic corrosion due to dissimilar metals (Col. 7, L. 55 – 60).

It would have been obvious to one of ordinary skill in the art to modify the reference of Rivera with the teaching of Matsui et al for performance.

Re: Claims 10 – 12, Rivera discloses a guide rail comprising:

- a first material body (114) having a nose portion (126); and
- a second material (124) secured to at least some of the nose portion,
- wherein the nose portion has a guiding surface (142) on opposite sides of the nose portion and a braking region near an end of the nose portion (any point along which the elevator car brakes, Col. 1, L. 43 – 52);
- wherein the second material is a covering that comprises a steel sheet (Col. 3, L. 48) extending over the braking region on each side of the nose portion;
- wherein the covering extends along an entire longitudinal length of the nose portion; however,

Rivera is silent with respect to the second material is only on the braking region of the nose portion.

Attention is directed to Matsui et al who teach their second material is only on the braking region of the nose portion (Fig. 62 – 65) of their guide rail (Col. 1, L. 11) as an alternative configuration.

It would have been obvious to one of ordinary skill in the art to modify the reference of Rivera with the teaching of Matsui et al as an applicable variation for utility.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Connolly (1,666,167), Ryznar (2,877,716) and Nohejl (2,824,526) are cited for references of rails comprising first and second materials, wherein said second materials are to improve friction and promote service life.

Thompson et al (6,371,261) and Wömpner et al (5,967,271) are cited for review of first- and second materials of braking elements and rails.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Kruer whose telephone number is 571.272.5913. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571.272.6856. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

/Stefan Kruer/

Examiner, Art Unit 3654

25 September 2008

/Peter M. Cuomo/

Supervisory Patent Examiner, Art Unit 3654